

REMARKS

Claims 1-82 are pending in this application. Claims 1-3, 10-11, 13-14, 28, 38-39, 50-51, 56-58, 60, 65, 67, 70, 80 and 82 have been now amended, claims 55 and 68 have been canceled, and new claims 83-87 have been added. After claim additions, amendments and cancellations herein, claims 1-54, 56-67 and 69-87 will be pending in this application. Reconsideration of the above-mentioned application in view of the following remarks is respectfully requested.

Rejections Under § 112

In the Office Action, the Examiner rejected claims 2-4, 13, 28, 38-41, 50, 51, 55-58, 60-65, 70, 80 and 81 under 35 U.S.C. § 112, second paragraph, as being indefinite due to various errors in language, antecedent basis, dependency and format in these claims. In response, Applicants have amended claims 2, 3, 28, 38, 39, 50, 51, 55-58, 60 and 65 to correct the lack of antecedent basis for “central processing unit”, claim 13 to correct the lack of antecedent basis for “filtering means”, claim 58 to correct the misspelling of “configured”, claim 70 to correct the dependency, and claim 80 to correct the inclusion of “pulse rate” and “blood pressure” within the Markush grouping for the term “blood constituents”. Applicants respectfully request that these rejections be withdrawn.

Rejections Under § 101

The Examiner also rejected claims 10, 11, 13 and 14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, because the claims define the device in relation to a body part of a living being, instead of that the various elements are “adapted to be” in their particular relation to the body part. In response, Applicants have amended claims 10, 11, 13 and 14 as suggested by the Examiner. Applicants respectfully request that this rejection be withdrawn.

Double Patenting Rejections

The Examiner rejected independent claim 66 as being a substantial duplicate of claim 55 (which depended directly from independent claim 1) and advised that one of these claims must be canceled. Applicants respectfully disagree with the Examiner and state that claims 55 and 66 are not substantial duplicates of each other and may remain together in this application because

they have a different claim scope. However, Applicants note that claim 55 has been canceled herein and its limitations incorporated into independent claim 1. Nevertheless, Applicants believe that amended claim 1, which incorporates the limitations of claim 55, and claim 66 may remain together in this application because they have a different claim scope.

Amended claim 1 requires that the processing device predict the blood constituent value of the patient based upon the spectral scan and *the first value*. By contrast, claim 66 requires that the central processing device predict the blood constituent value for the patient based upon the spectral scan and *the modeling equation*. Thus, claims 1 and 66 are not substantial duplicates and have different scope such that they may be maintained in the same application. Applicants request that this rejection be withdrawn.

The Examiner also rejected claims 55, 66, 74 and 78 for obviousness-type double patenting over claims 13, 21 and 23 of U.S. Patent No. 6,675,030 (Ciurczak et al.), stating that the claims of this application are broader but not patentably distinct from those of the '030 patent. According to the Examiner, the claims of this application are broader than those of the '030 patent (blood constituent is recited in the claims of this application, and blood glucose is recited in the '030 patent), and any method or system meeting the limitations of the '030 patent would necessarily meet those of this application.

In response, Applicants note their disagreement with the Examiner's obviousness-type double patenting rejection. Applicants believe that there are patentable differences between the system of claims 1 (claim 55 has been canceled herein and its limitations incorporated into amended independent claim 1) and 66 and the system of claim 23 of the '030 patent and between the methods of claims 74 and 78 of the present application and the methods of claims 13 and 21 of the '030 patent. However, for the purposes of expediting the prosecution of the present application, Applicants are prepared to submit an executed Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) over the '030 patent in order to obviate any obviousness-type double-patenting issues with respect to the present application. Applicants note that the obviation of an obvious-type double patenting rejection by the filing of a terminal disclaimer is not an admission, acquiescence or estoppel on the merits of an issue of obviousness. See *Quad*

Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 873-74, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991). Applicants will submit such a Terminal Disclaimer upon notification by the Examiner that the pending claims are otherwise allowable.

Prior Art Rejections

The Examiner also rejected claims 1-3, 5, 7-10, 26, 28-30, 32, 35-41, 49-54, 56, 57, 59, 67 and 69-71 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,507,288 B1 (Böcker et al.). The Examiner further rejected claims 1 and 80-82 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,882,301 (Yoshida). In addition, under 35 U.S.C. § 103(a), the Examiner rejected claims 4-6 as being obvious over Böcker et al. in view of U.S. Patent No. 5,840,020 (Heinonen et al.), claim 11 as being obvious over Böcker et al. in further U.S. Patent No. 5,068,536 (Rosenthal), claims 12-14, 20-27, 31, 33 and 43 as being obvious over Böcker et al. in further U.S. Patent No. 5,348,003 (Caro), claim 72 as being obvious over Böcker et al. in further view of U.S. Patent No. 6,558,351 (Steil et al.), claims 42 and 46-48 as being obvious over Böcker et al. in further view of U.S. Patent No. 6,045,502 (Eppstein), claims 15-17 as being obvious over Böcker et al. and Caro in further view of Eppstein, and claims 44 and 45 as being obvious over Böcker et al. and Caro in further view of U.S. Patent No. 5,243,465 (Fein).

Applicants note that claims 1 and 82 have been amended to incorporate therein the limitations of claim 55, which was not rejected by the Examiner for prior art reasons. Similarly, Applicants have amended claim 67 to incorporate therein the limitations of canceled claim 68, which was not rejected by the Examiner for prior art reasons. As such, Applicants submit that claims 1 and 82, as well as claims 2-54, 56-59, 80 and 81 that depend from claim 1, and claim 67, as well as its dependent claims 69-73, are now allowable. Applicants request that the Examiner withdraw his rejections under §§ 102(b) and 103(a).

Allowable Subject Matter

The Examiner has indicated that claims 58, 60, 73 and 74 contain allowable subject matter, that claims 18, 19, 34, 73, 75-77 and 79 would be allowable if rewritten in independent form including the limitations of their base and intervening claims, and that claims 58 and 60-65 would be allowable if rewritten to overcome the indefiniteness rejection and to include the

limitations of their base and intervening claims. Applicants thank the Examiner for his indication of allowable subject matter.

Applicants note that claim 1 has been amended, as discussed above. As such, Applicants believe that claims 18, 19, 34 and 58 as amended are now allowable due to their dependency from claim 1. Applicants have also amended claim 60 to incorporate the limitations of its base claim 1, as suggested by the Examiner, such that now amended independent claim 60 as well as its dependent claims 61-65 are allowable.

Applicants point out to the Examiner that no mention whatsoever was made by the Examiner of claim 68, i.e., the Examiner made no rejection of claim 68 but also did not indicate that claim 68 contains allowable subject matter. Applicants believe that claim 68 as filed contains allowable subject matter but would have been rejected for depending upon a rejected claim (claim 67), such that claim 68 would be allowable if rewritten in independent form including the limitations of their base and intervening claims. Accordingly, Applicants have canceled claim 68 and have incorporated its limitations into claim 67. Applicants respectfully submit that claim 67, as well as its dependent claims 69-73, are now allowable.

Applicants note that claims 75-77 and 79, which the Examiner stated contain allowable subject matter, are now allowable, as is claim 78, because they depend from base claim 74 that was rejected under double patenting and that would now be allowable due to the fact that Applicants agree to file a Terminal Disclaimer.

In order to claim the above subject matter that the Examiner stated is allowable, Applicants now also add new claims 83-87. New claims 83-87 correspond to original claims 18, 19, 34, 58 and 73 that the Examiner stated contain allowable subject matter but rewritten in independent form, including the limitations of their base and intervening claims and without the errors that gave rise to the Examiner's indefiniteness rejections. Namely, claim 18 and its base and intervening claims have been rewritten as claim 83, claim 19 has been rewritten as claim 84, claim 34 and its base and intervening claims have been rewritten as claim 85, claim 58 and its

base claim have been rewritten as claim 86, and claim 73 and its base claim have been rewritten as claim 87.

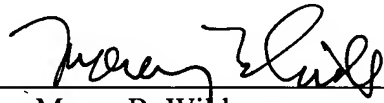
Conclusion

Reconsideration of the present application, as amended, is requested. In view of the above amendments and remarks, Applicant respectfully submits that amended claims 1-54, 56-67 and 69-87 are now in condition for allowance, except for the filing of a terminal disclaimer. If, upon review, the Examiner is unable to issue an immediate Notice of Allowance or an Action indicating that all claims will be in condition for allowance upon the filing of a terminal disclaimer, the Examiner is respectfully requested to telephone Applicant's undersigned attorney in order to resolve any outstanding issues and advance the prosecution of the case.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 
Morey B. Wildes
Reg. No. 36,968

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue - 14th Floor
New York, New York 10018
(212) 736-1940